

rejection made in the final action mailed 04/28/99. Reconsideration is requested on the basis of the argument in (8) ARGUMENT, Issue 1, of the 9/27/99 appeal brief incorporated here by reference.

The rejection of claims 1,8 and 23-34 on Senior under 35 USC 102(b) is the same rejection made in the final action of 04/28/99. Reconsideration is requested on the basis of the argument in (8) ARGUMENT, Issue 2 - Introduction, through Issue 2 - Claims 33 and 34, of the 9/27/99 appeal brief incorporated here by reference.

Reconsideration of the rejection of claims 37-41 under 35 USC 103(a) on Senior alone is requested. The Boesch decision is inapplicable here. In Boesch, the question was whether it would have been obvious to optimize alloying percentages, knowing that the percentage of particular alloying constituents affected the results. Here, the particular features at issue are not part of a continuum of alloy percentages, within which an optimum is sought; either the features are present, or they are not present. The obviousness of their presence should, instead, be resolved on the basis of the procedure of MPEP Section 2142, according to which three basic criteria must be satisfied, in order to have a valid prima facie obviousness rejection:

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

Proceeding on this basis, the suggestions in Senior are more: that the cap should not have anything which might make difficult its removal from its first position, for placement into its second position; that a stream of urine should be applied to member 16; and that reader/monitor 41 should be used to record the results. No references are combined with Senior in this

rejection; the examiner is requested to apply secondary references, if such exist. As it is, Senior does not teach or suggest the limitations of claims 37-41 regarding a snap fit cap, the dropping of the sample, in particular by pipette, and the photocopying of the results.

Reconsideration is also requested for the rejection of claims 37-39 under 35 USC 103(a) on Senior in view of Owens or Ullman. As pointed out above, Senior discloses a device in which the cap has to be movable, such that features from Owens or Ullman which would make this movement difficult would not have been obvious to one of ordinary skill in the art. The inclusion of claim 39 in this rejection is not understood, since claim 39 does not mention the snap-together feature.

Claim 42 has been added above toward the goal of providing a claim which further emphasizes features of distinction of the present invention over Senior. Claim 42 first sets forth that the assaying device combines a broad, lateral face with two narrow faces. Then, it places the sample deposit well in the broad, lateral face. Only "well" is used in claim 42, rather than "well/opening", since "well" better conveys the idea of the presence of a pocket, or depression, such as is visible, for instance, in Fig. 1 of the drawings, numeral 4b. This then is coupled with language from the bottom of page 3 of the specification, that a cap/cover is provided to cover and seal the well in a fluid tight relationship, following deposit of the sample.

Comparing claim 42 to Senior, Senior in contrast has its sample-collecting opening in a narrow end face, and the opening has member 16 filling and protruding out of it, rather than being in the nature of a well with a vacant space in its upper part.

It has been noted that the patent of Senior concerns a fundamentally different technology from that forming the basis for the present invention. A declaration of the third joint inventor,

Gary Hoffman, under 37 CFR 1.132 is attached to explain this different technology referenced in the BACKGROUND of the specification. Only three drops of urine are applied, compared with the massive soaking used in Senior. Claims 43 and 44 have been added to present alternative claims specifying the presence of this different technology.

Claim 43 is presented in the format provided in 37 CFR 75(e). The preamble specifies the environment in which the later specified improvement exists. The wording for the preamble specifying the different technology as compared to Senior has been taken from the BACKGROUND of the specification.

Claim 44 brings out the process differences. Urine is dropped into a well and the well then covered, in a drug test. In Senior, the idea is to have a patient urinate onto a protruding bibulous member and then cover the protruding member with a cap.

On the basis of the above amendment and remarks, reconsideration of the rejections and allowance of claims 1,8 23-34, and 37-44 are requested. The allowability of claims 35 and 36 is acknowledged.

Respectfully submitted,



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